

REMARKS

This responds to the Office Action mailed on December 23, 2008.

Claims 1, 12, 23, and 34 are amended, no additional claims have been canceled, and no claims are added; as a result, claims 1, 2, 4-8, 10-13, 15-19, 21-24, 26-30, 32-35, 37-41, and 43-48 are now pending in this application.

§ 112 Rejection of the Claims

Claims 1-2, 4-8, 10-13, 15-19, 21-24, 26-30, 32-35, 37-41 and 43-48 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

To expedite prosecution, independent claims 1, 12, 23, and 34 have been amended to provide antecedent basis for the term "said second entity, per the present rejection. In light of the amendments, Applicant respectfully asserts that the rejections under 35 U.S.C. § 112 have been overcome.

§ 103 Rejection of the Claims

Regarding Claims 1, 4-5, 10-12, 15-16, 21-23, 26-27, 32-34, 37-38 and 43-45

Claims 1, 4-5, 10-12, 15-16, 21-23, 26-27, 32-34, 37-38 and 43-45 were rejected under 35 U.S.C. § 103(a) as being obvious over Flanagan et al. (U.S. Patent No. 5,966,685, hereinafter; "Flanagan") in view of Gastaldo et al. (U.S. Patent No. 6,473,729, hereinafter; "Gastaldo").

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

A rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)). Emphasis added.)

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claimed elements.

Claim 1, as amended, includes the limitations of "receiving an identifier of a second entity from said first entity" and "communicating said translated language construct to said second entity."

Flanagan discusses "a system of parallel discussion groups operated in conjunction with a message collection/posting software program, data filter software program, and a machine translation software program."¹ The discussion groups in Flanagan run in "parallel" wherein one group for each language being used in the discussion groups.² These individual discussion groups "all contain the same information, in the same order; the only difference being that each parallel discussion group is written in a different language."³ A user may specify his or her language preference and the version of the discussion group corresponding to that language preference will be shown.⁴ Messages posted to one of the parallel discussion groups will be periodically collected, translated to other languages, and then posted to the parallel discussion groups for those respective languages.⁵ For example, a French user may log onto a discussion group and access the French version of the system where all the section names and messages will be in French.⁶ If the French user posts a message to the parallel discussion group, it will be translated into English and German and posted to the English and German versions of the system.⁷

In Flanagan, these posted messages "are not ordinarily addressed to any particular user."⁸ Additionally, "[n]o human intervention is required for the pre-processing, translation, or post-processing functions ..., users simply specify a language preference to realize the benefits and advantages of the present invention."⁹ In summary, Flanagan discusses the posting of messages on parallel discussion groups that are not directed at any **particular** user or other entity. In contrast, in claim 1, a communication is directed, in particular, to the second entity by "receiving

¹ Flanagan, col. 2, lines 21-24.

² Flanagan, col. 2, lines 24-27.

³ Flanagan, col. 2, lines 27-30.

⁴ Flanagan, col. 4, lines 21-24.

⁵ Flanagan, col. 5, lines 45-36; see also col. 2, lines 35-38.

⁶ Flanagan, col. 4, lines 25-27.

⁷ Flanagan, col. 4, lines 33-37.

⁸ Flanagan, col. 1, lines 36-39.

⁹ Flanagan, col. 3, lines 19-25.

... an identifier of a second entity,” “determining a translated language construct” based, in part, on the identifier of the second entity, and “communicating [the] translated language construct to [the] second entity.”

Furthermore, the Examiner argues that Flanagan teaches “retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity” in paragraph 12 of the Office Action and cites Flanagan col. 4, lines 21-37 and col. 5, lines 45-36 to support this. The Examiner then goes on to argue that this “is clear since it is well known in the networking arts that in order to communicate with another entity, one must have an identifier of sorts to do such, as seen in the cited areas of Flanagan.”¹⁰ Applicant respectfully disagrees.

The cited portions of Flanagan discuss a user logging onto a parallel discussion group and choosing a language preference. No other actions on the part of the user are required.¹¹ There is no first user selecting an identifier of a second user and there is no need to do so because, in Flanagan, a first user merely posts his message onto one of the parallel discussion groups and his message will automatically be translated and posted onto all parallel discussion groups. The first user does not need to send or select an identifier of a second user because the first user not sending the message to a second user and messages are translated and posted regardless of whether or not there is an identifier of a second user. In contrast, claim 1 recites receiving “an identifier of a second entity” from a first entity, “retrieving entity information relating to said second entity based on the identifier of said second entity,” retrieving a translated language construct based on this information, and communicating the translated language construct to the second entity.

The addition of Gastaldo does not cure this deficiency. Gastaldo discusses a system for “assisting a translator to get the right translation for any phrase”¹² in which text is inputted by the translator in a first language, word phrases are extracted from the text, a database is queried using the word phrase, and a translation of the extracted phrase is obtained and displayed to the translator.¹³ In summary, Gastaldo aids a translator in translating text inputted by the same

¹⁰ Office Action paragraph 43.

¹¹ Flanagan, col. 2, lines 21-25.

¹² Gastaldo, col. 1, lines 7 and 53-55.

¹³ Gastaldo, col. 2, lines 7-18.

translator. Gastaldo does not discuss a message communicated to another translator or entity, directed or otherwise. In contrast, claim 1 recites “receiving an identifier of a second entity from said first entity” and “communicating said translated language construct to said second entity.”

As such, the combination of Flanagan and Gastaldo fails to teach or suggest at least “receiving an identifier of a second entity from said first entity” and “communicating said translated construct to said second entity” as claimed in claim 1. Thus claim 1 and its dependent claims are not obvious in view of the combination of Flanagan and Gastaldo and should be allowed for at least the reasons above.

Independent claims 12, 23, and 34 recite similar limitations as claim 1. Therefore, for the reasons discussed above, claims 12, 23, and 34 and their dependent claims should be allowed for at least the reasons above.

Regarding Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 were rejected under 35 U.S.C. § 103(a) as being obvious over Flanagan and Gastaldo in further view of Scanlan (U.S. Patent No. 6,857,022).

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 all depend on independent claims 1, 12, 23, and 34 and incorporate all limitations therein. As discussed above, the combination of Flanagan and Gastaldo does not teach or suggest the limitations of “receiving an identifier of a second entity from said first entity” and “communicating said translated construct to said second entity.”

Scanlan discusses a “method of ordering a translation of an electronic communication, such as a web page or an email, using a one-click translation component displayed on the web page.”¹⁴ This method includes displaying an electronic communication and a “one-click” translation component to a user.¹⁵ When a user clicks the one-click translation component, the electronic communication is sent to a translation manager that obtains a translation of the electronic communication and “directs transmission of said translation of said electronic communication to said user.”¹⁶ In summary, a user requests a translation of an electronic

¹⁴ Scanlan, Abstract.

¹⁵ Scanlan, col. 2, lines 13-16.

¹⁶ Scanlan, col. 2, lines 18-28.

communication and the translated electronic communication is returned to the same user. There is no receiving of “an identifier of a second entity from said first entity” and there is no communicating of a translation to a second entity.

Thus, Scanlan, whether considered separately or in combination with Flanagan and Gastaldo, does not teach or suggest “receiving an identifier of a second entity from said first entity” and “communicating said translated construct to said second entity.” Thus, claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 should be allowed for at least the reasons articulated above.

Regarding Claims 8, 19, 30 and 41

Claims 8, 19, 30 and 41 were rejected under 35 U.S.C. § 103(a) as being obvious over Flanagan and Gastaldo in view of Christy (U.S. Patent No. 6,301,554).

“It is improper to combine references where the references teach away from their combination.”¹⁷

As stated above, Flanagan discusses the use of parallel discussion groups that all contain the same information in the same order; the only difference being that each parallel discussion group is written in a different language. Messages posted to one of the parallel discussion groups are not ordinarily addressed to any particular user and will be periodically collected, translated to other languages, and then posted to the parallel discussion groups for those respective languages.

Gastaldo discusses a system for assisting a translator in translating a phrase in which text is inputted by the translator in a first language, word phrases are extracted from the text, a database is queried using the word phrase, and a translation of the extracted phrase is obtained and displayed to the translator.

In the recent decision of the Supreme Court on *KSR Int’l Co. v. Teleflex Inc.*,¹⁸ the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*,¹⁹ was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the

¹⁷ MPEP § 2145 (citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).)

¹⁸ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

¹⁹ 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”²⁰

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.”²¹ In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*²².

A person of ordinary skill in the art would not have been led to combine Gastaldo’s tool for a translator, Flanagan’s parallel discussion groups, and Christy’s e-mail system. In fact, there would be no reason and no beneficial effect to including an e-mail system in Gastaldo’s tool for a translator, nor would there be any reason or beneficial effect to including an e-mail system in Flanagan’s parallel discussion groups. As person of ordinary skill in the art would not have been led to make the proposed combination of Flanagan, Gastaldo, and Christy, their combination is improper.

For the reasons above Applicant respectfully requests that the obviousness rejection of claims 8, 19, 30, and 41 be withdrawn.

²⁰ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

²¹ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

²² 383 U.S. 1 at 467.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4043 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 23, 2009.

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